APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/583,700	05/31/2000	Cary Lee Bates	ROC20000071	5217

7590	12/29/2003

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EXAMINER
WON, YOUNG N

ART UNIT	PAPER NUMBER
2155	

DATE MAILED: 12/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/583,700	BATES ET AL.
	Examiner	Art Unit	
	Young N Won	2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4,5,8-19,21,22,25-40 and 42-44* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4,5,8-19,21,22,25-40 and 42-44* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

    a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4)☐ Interview Summary (PTO-413) Paper No(s). _____.
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

1.   Claims 3, 6-7, 20, 23-24, and 41 have been cancelled. Claims 1-2, 4-5, 8-19, 21-

22, 25-40 and 42 have been re-examined. New claims 43 and 44 have been examined.

Claims 1-2, 4-5, 8-19, 21-22, 25-40 and 42-44 are pending with this action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the
United States before the invention thereof by the applicant for patent, or on an international application
by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this
title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act

of 1999 (AIPA) do not apply to the examination of this application as the application

being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily

published under 35 U.S.C. 122(b). Therefore, this application is examined under 35

U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2.   Claims 1-2, 5, 8-13, 17-19, 22, 25-30, 34-36, and 39-44 are rejected under 35

U.S.C. 102(e) as being anticipated by Adar et al. (US 6493702 B1).

Independent:

As per claims 1 and 18, Adar teaches a method (see title) and a

computer-readable medium having instructions or programs which, when executed by a

process cause the process to perform a method for managing bookmark information in

a data structure residing on a computer (see abstract: "distributed program"),

comprising: receiving the bookmark information from a plurality of sources networked to

the computer (see col.4, lines 18-24), the bookmark information comprising source

identifier information and network addresses (see col.1, line 60 to col.2, line 4); and

storing the bookmark information in the data structure (see col.4, lines 29-37 and col.5,

lines 58-65).

As per claim 35, Adar teaches an apparatus, comprising: a computer (see Fig.1);

at least one bookmarking device having a unique source identifier associated therewith

and containing a first browser adapted to process network addresses (see col.1, line 60

to col.2, line 4); and a network connection connecting the computer to the at least one

bookmarking device and comprising network addresses (see col.2, lines 53-58 & col.5,

lines 38-57: inherent), wherein the at least one bookmarking device transfers the

network addresses and unique source identifiers to the computer via the network

connection (see col.1, line 60 to col.2, line 4 and col.8, lines 46-49).

Dependent:

As per claims 2 and 19, Adar teaches of further comprising, collecting the

network addresses and source identifier information during an Internet browsing session

(see col.6, lines 1-3 and col.10, lines 32-47).

As per claims 5, 9, 22, 26, and 40, Adar further teaches wherein the data structure is a bookmark table having at least one bookmark entry (see Fig.6, #614 and col.6, lines 3-8).

As per claims 8 and 25, Adar teaches of further comprising populating a plurality of fields with the bookmark information to form the at least one bookmark entry (see Fig.5 and col.8, lines 51-56).

As per claims 10 and 27, Adar teaches of further comprising, prior to receiving the bookmark information, sending the bookmark information from at least one of the plurality of sources to the computer in an instance where a bookmark was generated at the at least one of the plurality of sources (see col.11, line 49 to col.12, line 4).

As per claims 11, 12, 28, and 29, Adar teaches of further comprising, prior to receiving the bookmark information: browsing a network connected to the plurality of sources (see col.1, lines 7-12) and comprising the network addresses (see col.1, lines 30-33); collecting the network addresses by one or more of the plurality of sources (see col.18, line 45); storing the network addresses as bookmarks (see col.10, lines 50-53); sending the bookmark information to the computer (see col.12, line 66 to col.13, line 4).

As per claims 13, 30, and 36, Adar further teaches wherein the network is the Internet, and the network addresses are Uniform Resource Locators (URLs) (see col.1, lines 27-33).

As per claims 17 and 34, Adar further teaches wherein the bookmark information received from the plurality of sources may be administered at a local computer based on the source identifier information (see abstract).

As per claim 39, Adar further teaches wherein the computer comprises a data structure for storing the network addresses and unique source identifiers (see col.8, lines 46-49).

As per claim 42, Adar further teaches wherein the computer further comprises a second browser for managing the data structure (see Fig.2, Fig.3, Fig.5, and Fig.6).

As per claims 43 and 44, Adar further teaches wherein the bookmark information comprises a plurality of bookmark entries (see Fig.6), each bookmark entry comprising a bookmarked network address and an associated source identifier identifying one of the plurality of sources on which the bookmark entry was created (see col.8, lines 46-49 and col.12, lines 48-56).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 4, 14-16, 21, 31-33, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adar et al. (US 6493702 B1).

As per claims 4, 14, 15, 21, 31, 32, and 38, Although Adar teaches refers the users (sources), as "computer users" (see col.1, line 15), Adar does not explicitly teach

wherein the plurality of sources or source identifier information is selected from the group comprising of a laptop, a cellular phone, e-mail, a personal data assistant, a set-top box, a watch, a hand-held computer, a pager, and a desktop computer.

However these differences are only found in nonfunctional descriptive material and are not functionally involved in the steps recited. The selection of source or source identifier information would be performed regardless of the group type, so long as it the group has the ability to communicate via the Internet as taught by Adar. Thus these descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see In re Gulack, 703 F.2d 1381,1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use any group device because such devices does not functionally relate to the steps in the method claimed so long as they are able to communicate via the Internet and because the subjective device type does not patentably distinguish the claimed invention.

As per claims 16 and 33, Although Adar teaches of "other identifiers" (see col.8, lines 47-48), Adar does not explicitly teach wherein the source identifier information is selected from the group comprising of person, location, sender, channel, program, and phone number.

Similarly as reasons set forth above regarding claims 4, 14, 15, 21, 31, 32, and 38, these differences are subjective and do not patentably distinguish the invention.

4.   Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adar et
al. (US 6493702 B1) in view of Smethers (US 6560640 B2). Adar does not teach
wherein the network connection comprises a wireless connection. Smethers teaches
wherein the network connection comprises a wireless connection (see col.3, lines 64-
67). It would have been obvious to a person of ordinary skill in the art at the time the
invention was made to employ the teachings of Adar within the system of Himmel by
employing a wireless network communication within the bookmarking apparatus
because Smethers teaches that the hypertext technology has spread to wireless
communications (see col.1, lines 11-12).
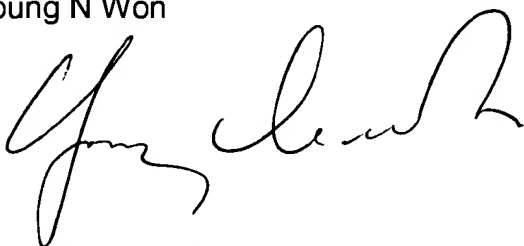
Response to Arguments

5.   Applicant's arguments, filed October 31, 2003, with respect to the rejection(s) of
claim(s) 1-42 under 35 USC 102(e) and 35 USC 103(a) have been fully considered and
are persuasive. Therefore, the rejection has been withdrawn. However, upon further
consideration, a new ground(s) of rejection is made in view of Adar et al. (US 6493702
B1).

6.   Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Young N Won whose telephone number is 703-605-
4241. The examiner can normally be reached on M-Th: 8AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Hosain T Alam can be reached on 703-308-6662. The fax phone number

for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is 703-305-

3900.

Young N Won

December 17, 2003

HOSAIN ALAM
SUPERVISORY PATENT EXAMINER